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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,381	08/05/2003	Martin S. Maltz	D/A2290	1288
41030 7590 11/10/2008 ORTIZ & LOPEZ, PLLC P. O. BOX 4484 ALBUQUERQUE, NM 87196-4484				
EXAMINER				
KAU, STEVEN Y				
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2625				
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11/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/635,381	<b>Applicant(s)</b> MALTZ ET AL.
<b>Examiner</b> STEVEN KAU	<b>Art Unit</b> 2625

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 October 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625

/Steven Kau/  
Examiner, Art Unit 2625  
11/6/2008

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's Remarks and arguments have been received on 10/25/2008. Applicant's arguments with respect to claim 1-22 have been fully considered and are not persuasive.

Applicant argues, "The Applicant respectfully disagrees with this assessment. First, the Shimizu reference makes no mention of "automatic input" in col. 11, lines 65 - col. 12, line 19. In fact, the cited material is actually an explanation of fig. 7 which specifically does not require any input. Col. 12 lines 44-46 states "... L, a and b, which are variables indicating the grid numbers of a grid point in an L\*a\*b\* space, are all initialized to 0". There simply is no input needed in this example because the values are initialized at 0. Indeed, there is absolutely no mention of input, much less automatic input, anywhere in the cited language. In addition the process being shown in flowchart seven is for the creation of a color conversion table. Thus, pretending this does teach automatic input, the Examiner still fails to establish why this particular feature of the present invention would be valuable for use in the present invention. There is absolutely no need for a color conversion table as claimed in the present invention and the automatic input of colors via a color conversion table would not improve the present invention at all. The Examiner has in effect, cited something from the reference which is not used or needed in the present invention to teach the limitations of the present invention. The present invention does not claim automatic input via a color conversion table", pages 7-8, Remarks.

In re, the examiner respectfully disagrees with the assertion. In the discussion of claim 10 rejection, page 8, Office Action dated 8/20/2008, the examiner clearly cited Figures 18, 19, 5 and 7 and col 11, lines 65 to col 12, line 19 for the limitation of "automatically provided as input to an image process device". Figure 18 discloses hardware requirement needed to realize the method of Shimizu' 277 by causing a computer to execute a program. Figure 19 explains the general usage of a color conversion table generated by the method. Figure 5 discloses an embodiment of color data conversion method, in which, the first step is "inputs an L\*a\*b\* value outside color gamut, and Figure 7 disclose how to generate a color conversion table, and col 11, lines 65 to col 12, line 19, disclose the teaching of "The L\*a\*b\* values in this table are designated as the input initial values of the second preferred embodiment." Given the hardware environment of color data conversion shown in Figures 18 and 19, a flow chart of inputting color value of Figures 5 and 7, and the detail description of the process of generating a result as input to another embodiment, the limitation of "automatically provided as input to an image process device" is taught with the above factual finding. Thus, the above assertion is not persuasive.

Applicant continues to argue, "Further, while Shimizu discusses "three-dimensional arrays," the Applicant respectfully disagrees that this teaches control of a particular dimensional order. The language is Shimizu clearly limits the reference to three-dimensional orders. As is made clear by the language of claim 10 and Applicant's specification, the "particular order" is not limited to the three-dimensional case. Applicant's abstract specifically notes dimensions are not limited and may include the two-dimensional case as well", page 9, Remark.

In re, the examiner respectfully disagrees. Applicant's argument of "Applicant's specification, the "particular order" is not limited to the three-dimensional case. Applicant's abstract specifically notes dimensions are not limited and may include the two-dimensional case as well" is not persuasive. It is noted that the features upon which applicant relies (i.e., may include the two-dimensional case) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The examiner also references the applicant to the claims rejection section below for the explanation on how the prior art references read on the amended claims.

Applicant continues to argue, "The Applicant also respectfully disagrees that use of a color sensor to determine which color has attained a gamut limit has been taught. The first evidence of this is the fact the Examiner has cited two separate sections of the Shimizu reference in arguing this single point of Applicant's invention. First, the Examiner cites col. 11, lines 65-67 and col. 12, lines 1-19 of Shimizu arguing this teaches use of a color sensor. This relates to the adoption by Shimizu of another patented method for creating color conversion tables. The Applicant is not asserting use of a color sensor is unique to the present invention. Indeed, color sensors are most assuredly used in many different types of applications. Rather, the Applicant is using the color sensor to determine which color value among the plurality of color values has reached the gamut limit, and not to create a color conversion table. It is important to understand that the entire process being described by the cited material and Fig. 7 of the referenced patent is being used to create a reference table. This is not the same as using a color sensor to determine if a color has reached the gamut limit. Indeed, the reference highlights the fact that the present claim is different because no table is created" and

"The Examiner appears to misunderstand the Applicant's argument. The Examiner continues to cite material in the reference that teaches the creation of a color conversion table. The present invention never teaches discusses, considers, describes, or even contemplates a color conversion table in any capacity. Therefore, citing the creation of a color conversion table to teach, the use of a color sensor for determining which color among a plurality has reached a gamut limit is insufficient to establish prima facie obviousness" and "Finally, the Examiner states in his response to this argument "Without a set of L\*a\*b\* input color value, how a color conversion process be performed?" (SIC). Of course a color value is needed to perform a color conversion. However, this does not logically mean the use of a color sensor in one invention logically teaches or suggests a different use of a color sensor in another. It is not the color sensor itself but the way in which the sensor is used that differentiates the present invention from the reference", pages 9-10, Remarks.

In re, the examiner respectfully disagrees. In the discussion of claim 10 rejection, for the limitation in the claim, "a color sensor for dynamically determining which color value among said plurality of color values has attained a gamut limit", the examiner did not address or discuss color conversion table, rather, the examiner quoted in the office action, "e.g. measurement of L\*a\*b\* values indicates that a color sensor must be used for color measuring" and "e.g. Shimizu discloses a flowchart or algorithm which has steps to determine shortest distance from boundary of color gamut in Figs 7 and 9 judging whether color value is near the color gamut boundary which is actively or dynamically performed", page 9, Office Action dated 8/20/2008. And these teachings are disclosed in the cited figures 7 and 9, and col 14, lines 50-64, col 12, lines 1-19, col 13, lines 5-37, and col 15, lines 41-66. The cited columns, lines and figures indicates that Shimizu' 277 reference teaches color data value is measured, judged and determine the shortest distance in the color gamut boundary. Thus, the above argument presented by the applicant is not persuasive.

Applicant continues to argue, "In addition, the Examiner's response to this argument that "a transform module must be used for n-ink process transformation process" is a conclusion the Examiner has established but is not taught by the reference. Prima facie obviousness requires that the reference itself actually teach or suggest all the limitations of the challenged invention. The Examiner's unsupported conclusion that a mathematical model could ever teach the specific real-world physical application described in the present invention is simply not enough to establish prima facie obviousness", page 11, Remarks.

In re, the examiner respectfully disagrees with this assertion. The above argument presented by the applicant was quoted from the reply to the arguments in the last office action. However, the applicant did not include the entire paragraph of the response, which recites, "In re, the examiner does not agree with the argument. Mahy's teaching, as a whole, is a mathematical model for calculating or determining color gamut "knowledge of this is important in color reproduction, in order to decide how colors outside the color gamut will be reproduction" (col 7, lines 45-48). Mahy discloses the relationship between n-ink process and m-ink process, which m-n (col 1, line 49 to col 2, line 60). Due to different colorant limitations, n-ink process transformation will produce different results as shown in Figures 3 & 4, col 14, line 50 to col 15, line 14. Thus, "a transform module" must be used for n-ink process transformation process", page 5-6, Action, 8/20/2008. Thus, the conclusion is based on Mahy's teaching, but not as the applicant said, "the Examiner's response to this argument that "a transform module must be used for n-ink process transformation process" is a conclusion the Examiner has established but is not taught by the reference". Thus, the above argument is not persuasive.

Applicant further argues, "Finally, per the decision in KSR Int'l v. Teleflex Inc., it is not enough that the Examiner identify all elements of Applicant's invention in past references (which the Applicant suggests the Examiner has still failed to do); the Examiner must also explicitly explain the reason one of ordinary skill in the art would have combined the referenced inventions in the way they are taught in Applicant's invention. The Examiner has cited col. 4, lines 17-43 suggesting this discussion explains the motivation for the combination of Shimizu and Mahy as a means for providing each and every claim limitation of Applicant's claims. The Examiner has failed to cite any material to explain how the combination of elements supposedly taught by Mahy would improve the Shimizu invention. Some actual citation to the references to explain the motivation for their combination is necessary under the KSR Int'l holding. Further, the Examiner has still failed to explain how a transformation module for automatically reducing a particular dimensional order based on determining which color value among said plurality of color values has attained said gamut limit, which the examiner claimed is taught by Mahy, would improve the Shimizu invention. The Examiner claims in the response to this argument that the three basic criteria of prima facie obviousness have been established. However, the Examiner has failed to make that analysis specific as required under the holding in KSR Int'l.

As evidence consider that the Examiner specifically stated Shimizu fails to teach a transformation module. This is because the Shimizu invention functions without the need for a transformation module. Thus, at the very least, it is the Examiner's burden to explain how stuffing a transformation module into an already functioning invention would improve that invention. The Examiner has only explained the result of such a combination (improved control of certain L\*a\*b\* colors) without explaining how the combination would yield such a result. Further, the Examiner claims the combination could yield predictable results without citing anything explaining how or what that predictable result would be. The Applicant respectfully asserts the predictable result would be the inclusion of a useless transformation module in an already functioning invention yielding no improvement to either the Shimizu or Mahy invention", pages 11-12, Remarks.

In re, the examiner respectfully disagrees with the above argument. With respect to claims 1 and 10, where claim 1 is directed to a method claim and claim 10 is directed to a system claim, and both claims has corresponding similar features. As discussed above and in the Office Action, 8/20/2008, every limitation is taught by Shimizu' 277 in view of Mahy' 109. For instance, Shimizu' 277 teaches every limitations of Claim 10, except for the limitation, recites, "that a transformation module for automatically reducing said particular dimensional order based on determining which color value among said plurality of color values has attained said gamut limit, thereby providing improved control for colors that are located external to said gamut". As discussed in the action, in the same field of endeavor, Mahy' 109 teaches this limitation and one having ordinary skill in the art at the time the invention was made would have modified the system of Shimizu' 277 to include the limitation of a transformation module for automatically reducing said particular dimensional order based on determining which color value among said plurality of color values has attained said gamut limit, thereby providing improved control for colors that are located external to said gamut since doing so would improve the control of an L\*a\*b\* value of a certain color which is outside a target color gamut, and therefore enable the optimal reproduction of images that certain colors that falls outside of the color gamut of the printer, and further the mathematical model provided by Mahy' 109 could be implemented for one another with predictable results. Thus, the examiner has explained in detail of how the claim limitations is taught by Shimizu' 277 in view of Mahy' 109. And the examiner presents a KSR Int'l case to the applicant.

As discussed in the reply in last action, the examiner has explained that the examiner meets the three basic criteria in establish a prima facie case of obviousness rejection in this application:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined) (MPEP 2143).

As discuss above, and in the last office action, same rational basis is equally applied to the arguments with regard to Claim 9 and the dependent claims.